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**EASTMAN KODAK COMPANY
PATENT LEGAL STAFF
343 STATE STREET
ROCHESTER, NEW YORK 14650-2201**

DATE: 21 September 2006

TO: EXAMINER: Mark T. Henderson FAX NO. 571-273-8300
GROUP 3722
U.S. PATENT OFFICE

FROM: Thomas J. Strouse FAX NO. (585) 477-4646
PHONE NO. 585-588-2728

RE: U.S. Serial No. 09/534,433
Filed March 23, 2000
Docket No.: 80521

Attached is Applicant's Appeal Brief.

Total Pages Including Cover Sheet 20

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80521F-P
Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

David L. Patton

A METHOD FOR PRINTING AND
VERIFYING LIMITED EDITION
STAMPS

Serial No. 09/534,433

Filed 23 March 2000

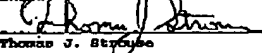
Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Sir:

Group Art Unit: 3722

Examiner: Mark T. Henderson

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by facsimile transmission to the United States
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Thomas J. Strouse
Sept. 21, 2006
Date

APPEAL BRIEF TRANSMITTAL

Enclosed herewith in triplicate is Appellants' Appeal Brief for the above-identified application.

The Commissioner is hereby authorized to charge the Appeal Brief filing fee to Eastman Kodak Company Deposit Account 05-0225. A duplicate copy of this letter is enclosed.

Respectfully submitted,


Attorney for Applicant(s)
Registration No. 27,370

Thomas J. Strouse/phw
Rochester, NY 14650
Telephone: 585-588-2728
Facsimile: 585-477-4646

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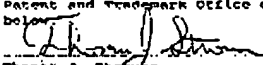
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Attorney for Applicant(s)
Registration No. 27,370

Thomas J. Strouse/phw
Rochester, NY 14650
Telephone: 585-588-2728
Facsimile: 585-477-4646

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SEP 21 2006

**Docket 80521TJS
Customer No. 01333**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of

David L. Patton

**A METHOD FOR PRINTING AND
VERIFYING LIMITED EDITION
STAMPS**


Serial No. 09/534,433

Filed 23 March 2000

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Group Art Unit: 3722
Confirmation No. 1516
Examiner: Mark T. Henderson

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Thomas J. Strouss
Sept 21, 2006
Date

Sir:

APPEAL BRIEF PURSUANT TO 37 C.F.R. 41.37 and 35 U.S.C. 134

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APPELLANT'S BRIEF ON APPEAL

Appellant hereby appeals to the Board of Patent Appeals and Interferences from the Examiner's Final Rejection of claims 12, 14, 18-23, 25 and 29-34 which was contained in the Office Action mailed June 9, 2006.

A timely Notice of Appeal was mailed on July 13, 2006.

Real Party In Interest

As indicated above in the caption of the Brief, the Eastman Kodak Company is the real party in interest.

Related Appeals And Interferences

No appeals or interferences are known which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

Status Of The Claims

Claims 12, 14, 18-23, 25, 29-34 are pending in the application and claims 1-11, 13, 15-17, 24, 26-28 have been cancelled.

Appendix I provides a clean, double-spaced copy of the claims 12, 14, 18-23, 25, 29-34 on appeal.

Status Of Amendments

Office Action mailed 11/29/00.
Amendment mailed 2/21/01.
Final Rejection mailed 5/4/01.
116 Amendment mailed 6/28/01.
Rejection mailed 8/1/01.
Amendment mailed 10/30/01.
Rejection mailed 2/15/02.
Amendment mailed 5/10/02.
Rejection mailed 8/14/02.
Amendment mailed 9/12/02.
Rejection mailed 11/25/02.
116 Amendment mailed 1/21/03.
Notice of Appeal mailed 2/24/03.

Rejection mailed 2/27/03.
Amendment mailed 5/27/03.
Final Rejection mailed 10/9/03.
116 Amendment mailed 11/26/03.
Advisory Action mailed 12/9/03.
Notice of Appeal mailed 1/5/04.
Appeal Brief mailed 3/4/04.
Examiners Answer mailed 5/28/04.
Reply Brief mailed 6/11/04.
Favorable Decision mailed 7/25/05.
Rejection mailed 11/17/05.
Amendment mailed 3/13/06.
Final Rejection mailed 6/9/06.
Notice of Appeal mailed 7/13/06.

Summary of Claimed Subject Matter

With respect to claim 12, Appellant's invention relates to a limited edition official postal stamp 20. *See at least* page 5, lines 12-22. More particularly, the limited edition official postal stamp 20 includes a first indicia 10 identifying said limited edition official postal stamp as being a limited edition, wherein the first indicia includes a unique ID that identifies said limited edition official postage stamp as being one out of a predetermined number. *See at least* page 5, lines 12-19; page 7, lines 18-28; and Fig. 1. The limited edition official postal stamp also includes a second indicia 30 which is not visible under normal viewing conditions for confirming that said limited edition official postal stamp is a valid limited edition official postal stamp, said second indicia is not capable of being scanned for reproduction. *See at least* page 5, lines 12-19; page 7, lines 18-28; and Fig. 1.

With respect to claim 23, Appellant's invention relates to a sheet of limited edition official postal stamp 20. *See at least* page 5, lines 12-22; page 7, 3-17 and Fig. 2. Each limited edition official postal stamp 20 includes a first indicia 10 identifying said limited edition official postal stamp 20 as being a limited edition, wherein the first indicia 10 includes a unique ID that identifies said limited edition official postage stamp as being one out of a predetermined number. *See at least*

page 5, lines 12-19; page 7, lines 18-28; and Fig. 1. Each limited edition official postal stamp also includes a second indicia which is not visible under normal viewing conditions for confirming that said limited edition official postal stamp is a valid limited edition official postal stamp, said second indicia is not capable of being scanned for reproduction. *See at least* page 5, lines 12-19; page 7, lines 18-28; and Fig. 1.

With respect to claim 34, Appellant's invention relates to a limited edition official postal stamp 20. *See at least* page 5, lines 12-22. More particularly, the limited edition official postal stamp 20 includes a first indicia 10 identifying said limited edition official postal stamp 20 as being a limited edition, wherein said first indicia 10 includes a unique ID. *See at least* page 5, lines 12-19; page 7, lines 18-28; and Fig. 1. The limited edition official postal stamp 20 also includes a second indicia 30 which is not visible under normal viewing conditions for confirming that said limited edition official postal stamp is a valid limited edition official postal stamp, said second indicia is not capable of being scanned for reproduction. *See at least* page 5, lines 12-19; page 7, lines 18-28; and Fig. 1.

Grounds of Rejection to be Reviewed on Appeal

The following issues are presented for review by the Board of Patent Appeals and Interferences:

1. Whether the invention of claims 12, 14, 18-23, 25 and 29-34 is anticipated under 35 U.S.C. 102(b) over Guttag (U.S. Pat No. 5,120,089), or in the alternative, unpatentable under 35 U.S.C. 103(a) over Guttag (U.S. Pat No. 5,120,089) in view of Denenberg (U.S. Pat No. 5,120,089) and Schlauch (U.S. Pat No. 6,082,774).

Arguments**REJECTIONS UNDER 35 U.S.C. 102(b) OVER GUTTAG (U.S. PAT NO. 5,120,089), OR IN THE ALTERNATIVE, UNDER 35 U.S.C. 103(a) OVER GUTTAG (U.S. PAT NO. 5,120,089) IN VIEW OF DENENBERG (U.S. PAT NO. 5,120,089) AND SCHLAUCH (U.S. PAT NO. 6,082,774)****Claims 12, 14, 18-23, 25 and 29-34**

1. CLAIMS 12, 14, 18-23, 25 and 29-34 ARE NOT ANTICIPATED UNDER 35 U.S.C. §102(e) BY GUTTAG, AND ARE PATENTABLE UNDER 35 U.S.C. 103(a) OVER GUTTAG IN VIEW OF DENENBERG AND SCHLAUCH BECAUSE GUTTAG, DENENBERG AND SCHLAUCH FAIL TO SHOW ALL OF THE ELEMENTS RECITED IN CLAIMS 12, 14, 18-23, 25 AND 29-34.
 - a. GUTTAG DOES NOT DISCLOSE, EXPRESSLY OR INHERENTLY, A SECOND INDICIA FOR CONFIRMING THAT SAID LIMITED EDITION OFFICIAL POSTAL STAMP IS A VALID LIMITED EDITION OFFICIAL POSTAL STAMP AS REQUIRED BY APPELLANT'S INDEPENDENT CLAIMS.

Guttag fails to teach or suggest at least a second indicia which is not visible under normal viewing conditions for confirming that said limited edition official postal stamp is a valid limited edition official postal stamp as required by Appellant's independent claims. Rather, Guttag discloses that an expert or expert committee can individualize the marking of the philatelic item to distinguish each specific philatelic item. More specifically, Guttag discloses that "the expert can serially number all philatelic items expertized by him or her starting with 1 and going to 500 or more," e.g., serialize a number of known "Inverted Jenny" defective stamps. See Col. 4, lines 3-16. Appellant respectfully submits that the subsequent marking of philatelic items by an expert examining Inverted Jenny defective stamps, for example, and placing an expert's mark on the stamps, such as a serial or series number to *500 or more*, is not the same as purposely providing

a limited edition of a stamp. Thus, Guttag does not disclose a limited edition official postage stamp.

Moreover, Guttag does not disclose, expressly or inherently, a second indicia for confirming that the limited edition official postal stamp is a valid limited edition official postal stamp, i.e., a stamp being one out of a predetermined number. The final Office Action's inherent use of "irregularities in ink, bubbles in ink and/or fibers of the paper . . . that is not capable of being scanned" does not confirm that said limited edition official postal stamp is a valid limited edition official postal stamp, i.e., a stamp being one out of a predetermined number. "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result for a given set of circumstances is not sufficient." *Continental Can Co. v. Monsanto Co.*, 948 F. 2d 1264, 1269, 20 USPQ 1746, 1749 (Fed. Cir. 1991).

Accordingly, Guttag does not teach, expressly or inherently, a second indicia for confirming that the limited edition official postal stamp is a valid limited edition official postal stamp. Therefore, Appellant respectfully submits that Appellant's independent claims are patentable over the cited reference.

b. DENENBERG DOES NOT DISCLOSE, EXPRESSLY OR INHERENTLY, A SECOND INDICIA FOR CONFIRMING THAT SAID LIMITED EDITION OFFICIAL POSTAL STAMP IS A VALID LIMITED EDITION OFFICIAL POSTAL STAMP AS REQUIRED BY APPELLANT'S INDEPENDENT CLAIMS.

Denenberg fails to remedy the deficiencies of Guttag as Denenberg fails to teach or suggest at least a second indicia which is not visible under normal viewing conditions for confirming that said limited edition official postal stamp is a valid limited edition official postal stamp as required by Appellant's independent claims. Rather, Denenberg discloses that microscopic anomalies created from a manufacturing or printing of an art object, such as a painting, gives the object a unique signature. See Col. 3, lines 52-59. More specifically, Denenberg encrypts images of the microscopic anomalies (i.e., called reference

sites) along with various text information including a serial or series number if the art object is part of a series or limited edition. The encrypted information for each microscopic anomaly is stored as an index record for art object registration. *See* Col. 5, lines 36-55; Col. 9, lines 46-48; Col. 10, lines 44-55. However, Denenberg does not disclose that the index record is stored as a second indicia on a limited edition official postage stamp which is not visible under normal viewing conditions for confirming that said limited edition official postal stamp is a valid limited edition official postal stamp, i.e., a stamp being one out of a predetermined number.

Accordingly, Denenberg does not teach, expressly or inherently, a second indicia for confirming that the limited edition official postal stamp is a valid limited edition official postal stamp. Therefore, Appellant respectfully submits that Appellant's independent claims are patentable over the cited reference.

c. SCHLAUCH DOES NOT DISCLOSE, EXPRESSLY OR INHERENTLY, A SECOND INDICIA FOR CONFIRMING THAT SAID LIMITED EDITION OFFICIAL POSTAL STAMP IS A VALID LIMITED EDITION OFFICIAL POSTAL STAMP AS REQUIRED BY APPELLANT'S INDEPENDENT CLAIMS.

Schlauch fails to remedy the deficiencies of Gutttag and Denenberg as Schlauch fails to teach or suggest at least a second indicia which is not visible under normal viewing conditions for confirming that said limited edition official postal stamp is a valid limited edition official postal stamp as required by Appellant's independent claims. Rather, Schlauch merely discloses a human readable limited edition marking 520 on the back of an envelope. *See* Col. 17, lines 56-57. However, Schlauch also does not confirm, expressly or inherently, that a limited edition official postal stamp is a valid limited edition official postage stamp, i.e., a stamp being one out of a predetermined number.

Accordingly, Schlauch does not teach, expressly or inherently, a second indicia for confirming that the limited edition official postal stamp is a valid

limited edition official postal stamp. Therefore, Appellant respectfully submits that Appellant's independent claims are patentable over the cited reference.

Thus, it is submitted that further consideration of claim rejections under 35 USC 103(a) upon the citing of the fourth and fifth applied prior art references to Martin and Burnham is moot, inasmuch as the combination of Gutttag, Denenberg, Schlauch, Martin and Burnham still lack any teaching, disclosure, or suggestion concerning confirming that a limited edition official postal stamp is a valid limited edition official postage stamp as previously discussed. Martin and Burnham were merely cited to disclose the use of ultra-violet inks for preventing photocopying.

d. CONCLUSION

Accordingly, Gutttag, Denenberg, Schlauch, Martin and Burnham do not teach, expressly or inherently, a second indicia which is not visible under normal viewing conditions for confirming that the limited edition official postal stamp is a valid limited edition official postal stamp. Therefore, Appellant respectfully submits that claims 12, 14, 18-23, 25 and 29-34 are patentable over the cited references.

2. CLAIMS 12, 14, 18-23, 25 AND 29-34 ARE NOT ANTICIPATED UNDER 35 U.S.C. §102(E) BY GUTTAG, AND ARE PATENTABLE UNDER 35 U.S.C. 103(A) OVER GUTTAG IN VIEW OF DENENBERG AND SCHLAUCH BECAUSE THE REFERENCES ARE NOT PROPERLY COMBINABLE.

Appellant respectfully contends that a *prima facie* case of obviousness has not been established, as described more fully below. To establish a *prima facie* case of obviousness, three basic criteria must be met:

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2) there must be a reasonable expectation of success; and
- 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations.
(M.P.E.P. §2142).

Appellant respectfully submits that the cited references do not teach or suggest all the claim limitations as discussed above.

Further, there must be some actual *motivation* to combine the references found in the references themselves, the knowledge of one of ordinary skill in the art or from the nature of the problem to be solved that would suggest the combination. Without a suggestion of the desirability of “the combination,” a combination of such references is made in hindsight, and the “range of sources available, however, does not diminish the requirement for actual evidence.” *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). It is a requirement that actual evidence of a suggestion, teaching or motivation to combine prior art references be shown, and that this evidence be “clear and particular.” *Id.* Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

For example, it is respectfully submitted that Guttag fails to provide any suggestion to implement or otherwise be combined with a method of producing collector-targeted memorabilia articles by affixing one or more integral collectible attractiveness attribute to selected base articles as described in Schlauch. Moreover, Schlauch fails to provide any suggestion to implement or otherwise be combined with a method of protecting philatelic items as described in Guttag.

Thus, Appellant respectfully contends that a *prima facie* case of obviousness has not been established as no “clear and particular” evidence of motivation to combine can be identified.

Further, in discussing a combination of Guttag and Schlauch, the Examiner states that “it would have been obvious to, if not already, to one having ordinary skill in the art at the time the invention was made to provide limited edition indicia on the stamp of Guttag as, for example, illustrated in the Schlauch reference, so as to . . . assure the collector as to the overall number of the item.” However, the need to “assure the collector as to the overall number of the item” is what Guttag teaches is the benefit of the Guttag invention itself, and not a motivation to combine with Schlauch. The Examiner must show some objective teaching leading to the combination. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d

1596, 1600 (Fed. Cir. 1988). It is respectfully submitted that there is no such objective teaching in at least Gutttag that leads "to the combination" of Gutttag with Schlauch, and the Examiner has pieced together aspects purportedly found in the prior art to arrive at the invention through hindsight. As stated by the Federal Circuit:

"Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight."

In re Dembiczak, 50 USPQ2d 1614, (Fed. Cir. 1999) (citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985); emphasis added).

As such, there is no basis in the references themselves to motivate a person skilled in the art to combine at least the Gutttag reference with the Schlauch reference.

Conclusion

For the above reasons, Appellant respectfully requests that the Board of Patent Appeals and Interferences reverse the rejection by the Examiner and mandate the allowance of Claims 12, 14, 18-23, 25 and 29-34.

Respectfully submitted,



Attorney for Appellant
Registration No. 53,950

Thomas J. Strouse/phw
Telephone: 585-588-2728
Facsimile: 585-477-4646

Enclosures

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.

Appendix I - Claims on Appeal

12. A limited edition official postal stamp comprising:
a first indicia identifying said limited edition official postal stamp as being a limited edition, wherein said first indicia comprises a unique ID that identifies said limited edition official postage stamp as being one out of a predetermined number;

a second indicia which is not visible under normal viewing conditions for confirming that said limited edition official postal stamp is a valid limited edition official postal stamp, said second indicia is not capable of being scanned for reproduction.

14. A limited edition official postal stamp according to claim 12 wherein said first indicia is visible.

18. A limited edition official postal stamp according to claim 12 wherein said second indicia is made using an ink that can be seen when viewed under UV or infrared light.

19. A limited edition official postal stamp according to claim 12 wherein a third indicia is provided for identifying a printer or a location where said limited edition official postal stamp was printed.

20. A limited edition official postal stamp according to claim 19 wherein said third indicia is not visible under normal viewing conditions.

21. A limited edition official postal stamp according to claim 20 wherein said third indicia is not capable of being scanned for reproduction.

22. A limited edition official postal stamp according to claim 21 wherein said third indicia is made using an ink that can be seen when viewed under UV or infrared light.

23. A sheet of limited edition official postal stamp, each stamp comprising:

a first indicia identifying said limited edition official postal stamp as being a limited edition, wherein said first indicia comprises a unique ID that identifies said limited edition official postage stamp as being one out of a predetermined number;

a second indicia which is not visible under normal viewing conditions for confirming that said limited edition official postal stamp is a valid limited edition official postal stamp, said second indicia is not capable of being scanned for reproduction.

25. A sheet of limited edition official postal stamps according to claim 23 wherein said first indicia is visible.

29. A sheet of limited edition official postal stamps according to claim 23 wherein said second indicia is made using an ink that can be seen when viewed under UV or infrared light.

30. A sheet of limited edition official postal stamps according to claim 23 wherein a third indicia is provided for identifying a printer or a location where said limited edition official postal stamp was printed.

31. A sheet of limited edition official postal stamps according to claim 30 wherein said third indicia is not visible under normal viewing conditions.

32. A sheet of limited edition official postal stamps according to claim 31 wherein said third indicia is not capable of being scanned for reproduction.

33. A sheet of limited edition official postal stamps according to claim 32 wherein said third indicia is made using an ink that can be seen when viewed under UV or infrared light.

34. A limited edition official postal stamp comprising:
a first indicia identifying said limited edition official postal stamp as being a limited edition, wherein said first indicia comprises a unique ID;

a second indicia which is not visible under normal viewing conditions for confirming that said limited edition official postal stamp is a valid limited edition official postal stamp, said second indicia is not capable of being scanned for reproduction.

Appendix II - Evidence

None

Appendix III -- Related Proceedings

None